

DOC. NO: 209313US3PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :  
KENICHI OTANI, ET AL. : EXAMINER: MAI, T. M.  
SERIAL NO: 09/868,040 :  
FILED: JULY 23, 2001 : GROUP ART UNIT: 3727  
FOR: MOLDED ARTICLE :

REPLY BRIEF

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

The present Reply Brief is in response to the Examiner's Answer of November 17, 2004.<sup>1</sup> Appellants respectfully reiterate that the basis for the outstanding rejections set forth in the Examiner's Answer of November 17, 2004 are improper and must be REVERSED.

The outstanding rejections, discussed in detail in the Appeal Brief filed August 10, 2004 are based upon the teachings of Kieckhefer, Clay, Hatch, and Taylor. It is the Examiner's position that these references are properly combinable.<sup>2</sup> However, Appellants respectfully submit that this is not the case.

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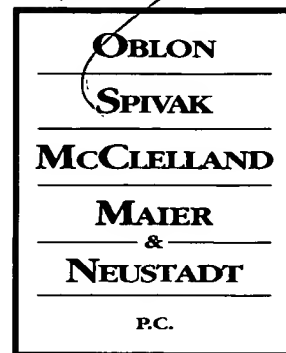
<sup>1</sup> Appellants note that the Advisory Action indicates that the outstanding rejections under 35 U.S.C. § 112, first and second paragraphs are withdrawn. However, the Advisory Action further indicates that the amendment will not be entered for purposes of appeal. Because the outstanding rejections under 35 U.S.C. § 112 have been withdrawn, Appellants assume that the amendment was entered.

<sup>2</sup> It is also the Examiner's position that Claims 11 and 12 stand or fall together. However, as stated at page 3 of the Applicants' Appeal Brief, Claims 11 and 12 do not stand or fall together. Claims 11 and 12 are both independent claims, and presently stand rejected on different grounds.



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ATTORNEYS AT LAW

RE: Application Serial No.: 09/868,040  
Applicants: Kenichi OTANI, et al.  
Filing Date: July 23, 2001  
For: MOLDED ARTICLE  
Group Art Unit: 3727  
Examiner: MAI, TRI M.

SIR:

Attached hereto for filing are the following papers:

**REPLY BRIEF**

**REQUEST FOR ORAL HEARING (IN DUPLICATE)**

Our credit card payment form in the amount of \$1,000.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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As set forth in MPEP § 2141.03, the prior art must be considered in its entirety, including the disclosures that teach away from the claims. It is respectfully submitted that that requirement has not been satisfied in this case.

Kieckhefer describes a nested cup. Kieckhefer seeks to prevent these nested cups from becoming wedged together when stacked. To this end, Kieckhefer describes that the nesting engagement must be limited by contact between the walls to prevent the cups from stacking too closely.<sup>3</sup> In fact, Kieckhefer teaches away from having an angle of 85° or greater between an outer surface of the sidewall of the body and a ground contact plane of the bottom portion, as recited in Claim 11. Thus, to combine Kieckhefer with Hatch or Taylor violates the requirements of MPEP § 2141.03.

Clay does not disclose or suggest a pulp molded article having an angle of 85° or greater. The Examiner's Answer relies upon an extrinsic evidence (e.g., a measurement with a protractor) of a drawing that is not indicated to be to scale to support the assertion that Clay provides an angle of 85°. Despite this unfounded assertion, there is no teaching in Clay that the angle between an outer surface of the sidewall of the body and a ground contact plane of the bottom portion is 85° or greater, as recited in Claim 11.

With respect to Claim 12, the Examiner's Answer asserts that "elementary physics" requires that the containers of Kieckhefer and Clay inherently have a density  $\rho_2$  smaller than a density  $\rho_1$  at portions 5 and 6 due to the molding process. The Examiner relies upon this assertion to support his taking of Official Notice. However, as set forth in MPEP § 2144.03, "it would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well-known are not capable of instant and unquestionable demonstration as being well-known." (emphasis in original).

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<sup>3</sup> Kieckhefer, col. 1, lines 15-20.

Despite Appellants' repeated request that a reference be cited in support of the Official Notice taken by the Examiner, no reference has ever been cited to support the Examiner's assertions.<sup>4</sup>

Moreover, the Examiner has failed to properly consider the Appellants' Declaration Under 37 C.F.R. §1.132. As set forth in MPEP §§ 716.02-716.02(g), any *prima facie* case of obviousness may be rebutted by evidence of superior or unexpected results. The Appellants have properly provided such evidence of unexpected results. Thus, under the requirements of MPEP § 716.02, this evidence must be considered by the Examiner.

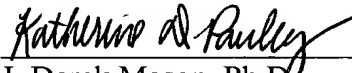
Therefore, for at least the foregoing reasons, Appellants respectfully submit that the outstanding rejections must be REVERSED.

Respectfully submitted,

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<sup>4</sup> See, e.g., Applicants' response filed November 7, 2003, page 4, and Applicants' response filed May 13, 2003, page 4.